

III. REMARKS

1. Claims 1-26 and 29 remain in the application. Claims 27, 28, and 30-32 have been cancelled without prejudice.

2. Applicants respectfully request reconsideration of the restriction requirement of invention III, claim 29, dated 4 September 2003.

The restriction requirement states that inventions I, claims 1-26, and III, claim 29, are unrelated and recites Form Paragraph 8.20.02 which states that "Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. (MPEP §806.04, MPEP §808.01)."

Examiner's Note 1 for this form paragraph states:

1. This form paragraph is to be used only when claims are presented to unrelated inventions, e. g., a necktie and a locomotive bearing.

Applicants submit that inventions I and III are not unrelated under the standards of MPEP §806.04 and MPEP §808.01.

Inventions I and III are disclosed as capable of use together. The method of claim 1 is described in the specification, for example, on page 12, line 24 through page 14, line 8 with reference to Figures 5 and 6. Server 14 and databases 141, 142, 144 are utilized in the method as shown in these figures.

Server 14 and databases 141, 142, 144 may be implemented as a computer program product as disclosed in the specification on page 11, lines 8-12:

[t]he server 14 and databases (141, 142, and 144) are preferably implemented as a computer program (or several programs interconnected) that is executable by a computer system and that is stored on a computer-readable program storage medium such as a on a disc or in ROM memory (hard disc) of the computer.

Thus, the server 14 and databases as shown in the embodiment of Figure 3 may be configured to operate under control of the computer program. The server 14 can be a component of a system as shown in Figure 1. From the specification, it is clear that the method is implemented by the server, under control of the computer program, and thus the method may be run by the computer program product. Therefore, the method of invention I and the computer program product of invention III are in fact disclosed as capable of use together.

Because the method is implemented by the computer program product, inventions I and III have the same mode of operation, function, and effect. Therefore, the method of invention I and the computer program product of invention III do not have different modes of operation, different functions, or different effects.

At least for these reasons, Applicants respectfully submit that inventions I and III are disclosed as capable of use together and do not have different modes of operation, different functions, or different effects. Applicants further submit that the restriction of invention III is improper and request reconsideration and withdrawal of the requirement.

3. Applicants respectfully submit that claims 1-3, 5-7, 9-12, 14-21, 23, 25 and 26 are patentable over the combination of Filler et al. (WO 00/11827, "Filler") in view of Yu et al. (US 6,684,087, "Yu").

The combination of Filler and Yu fails to disclose or suggest the following feature of claim 1:

3) that associating a digital collectible card with the user is based on the identification of the user in the cellular mobile communication network, which identification is received from the cellular mobile phone.

The combination of Filler and Yu also fails to disclose or suggest the following features of claim 21:

3) an associating process based on an identification of the user in the cellular mobile communication network received from the cellular mobile phone.

The disclosure of Filler et al. is entirely focused on a fixed network Internet solution. No other teaching exists in Filler. Filler fails to teach a cellular mobile communication network and a cellular mobile phone. Further, page 2, lines 17-20, discloses a general concept of uniquely associating the card to the user, and gives only one example of this on page 15, lines 28-32, in which the user enters the username and the corresponding password. There is no disclosure or suggestion of the present invention.

At the time of Filler, GSM technology with identification and location features by itself was widely available, and therefore known to one skilled in the art. Yet, there has been no implementations of this technology that is similar to, and that includes all the features of the present invention and no solution as presented by the present invention. On the contrary, the disclosure of Filler is only related to a fixed connection Internet system utilizing an association based on a user ID and password that must be typed and entered by the user.

Since Filler et al. was laid open to the public on 2 March 2000, no similar solutions have been published. Indeed the fact that Filler fails to disclose any aspects relayed to mobility and that no other similar disclosure exists could be seen as an indication of inventiveness. Applicants actually disclosed Filler, but are of the opinion that the present invention clearly provides a different and more advanced digital trading card system in a totally different new environment.

Yu fails to teach or disclose the features missing from Filler.

Applicants note that the Office Action fails to identify any specific passage or portion of Yu as being pertinent. According to MPEP 706.02(j)

After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

On col. 6, lines 13-16, Yu discloses that "[e]ach of the mobile devices, such as 350, is assigned with a device identifier or identification (ID). Device ID may be a phone number of the device..."

Furthermore, the disclosure of Yu teaches on col. 6, lines 18-22 that "[t]he device ID is further associated with a subscriber ID created and administrated by a carrier administrating link server 300 as part of the procedures to activate a subscriber account for mobile device 350."

Thus, Yu does not disclose any digital trading card but instead is focused on processing a digital image generally in known available form. Furthermore, based on the teaching of Yu, a user ID is only used to identify a specific user account and to establish instructions to pre-process the image in the intermediate server. The actual association of the image takes place only upon an explicit request by the user.

Furthermore, the combination of Yu and Filler faces serious technical difficulties. Contrary to the statements in the Office Action on page 4, A computer, PDA, laptop are not equivalent to a cellular mobile phone.

Yu provides no technical means to just "transfer" the fixed network computer oriented trading card system to the cellular mobile world. The field of endeavor is not the same, there are practical difficulties in the combination, and the feature with respect to the association is completely different and inadequate.

A benefit of the present invention is the synergy that can be achieved, as the association of the user with the digital trading card is based on the identification of the user of the cellular mobile phone in the cellular mobile communication network. The association is based on the identification of the user in the cellular mobile communication network received from the cellular mobile phone. Furthermore, the centralized server based management of the trading card system is very suitable for cellular mobile phone applications.

At least for these reasons, Applicants respectfully submit that claims 1 and 21 are patentable over the combination of Filler and Yu.

Claims 2, 3, 5-7, 9-12, 14-20, 23, 25, and 26 depend from claim 1 or from claim 21 and therefore are also patentable over the combination of Filler and Yu.

4. Applicants respectfully submit that claim 4 is patentable over the combination of Filler, Yu and Beuk et al. (US 5,774,673, "Beuk").

Claim 4 depends from claim 1. Beuk fails to provide the features of claim 1 missing from the combination of Filler and Yu and therefore fails to render claim 4 unpatentable.

5. Applicants respectfully submit that claim 13 is patentable over the combination of Filler, Yu, and Peppel (US 6,200,216).

Claim 13 depends from claim 1. Peppel fails to provide the features of claim 1 missing from the combination of Filler and Yu and therefore fails to render claim 13 unpatentable.

6. Applicants respectfully submit that claims 8 and 24 are patentable over the combination of Filler, Yu and Treyz et al. (US 6,587,835), "Treyz").

Claim 8 depends from claim 1 and claim 24 depends from claim 21. Treyz fails to provide the features of claims 1 and 21 missing from the combination of Filler and Yu and therefore fails to render claims 8 and 24 unpatentable.


7. Applicants respectfully submit that claim 22 is patentable over the combination of Filler, Yu, and Atsmon et al. (US 6,607,136, ("Atsmon").

Claim 22 depends from claim 21. Atsmon fails to provide the features of claim 1 missing from the combination of Filler and Yu and therefore fails to render claim 22 unpatentable.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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